

REMARKS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the following remarks. Claims 1-18 were pending prior to the Office Action. Claims 19-31 have been added by this Reply. Therefore, claims 1-31 are pending. Claims 1, 5, 18, 19, and 24 are independent.

Specification

The paragraph beginning on page 21, line 5, has been amended to read "gain correction" instead of "exposure control". This paragraph is part of the description corresponding to the third embodiment of the present invention, and one of the main topics of discussion regarding the third embodiment is gain correction. No new matter is introduced by the amendment.

Applicants respectfully request that the amendment to the specification be accepted.

Drawings

As noted above, FIGS. 4 and 14 have been amended. In FIG. 4, the symbol "r" in steps ST2 and ST3 have been changed to "7" (see *specification, page 14 for support*). In FIG. 14, the label for the Fixed Length Decoding Circuit is changed to "7b" (see *specification, page 26 for support*). No new matter has been added by the amendments to the drawings.

Applicants respectfully request that the revised formal drawings be approved and that the Examiner provide a Notice of Draftsperson's Patent Drawing Review, Form PTO-948, confirming approval by the Official Draftsperson, with the next official communication.

Rejection under 35 U.S.C. §102(e)

Claims 1, 12-14, and 18 are rejected under 35 U.S.C. §102(e) as being anticipated by Takayama (U.S. Patent No. 6,512,791, hereinafter "Takayama"). Applicants respectfully traverse this rejection.

For a Section 102 rejection to be proper, the cited reference must teach or suggest every claimed element. See *M.P.E.P.* 2131; *M.P.E.P.* 706.02. Thus, if a cited reference fails to teach or suggest one or more elements, the rejection is improper and must be withdrawn.

In the Office Action, it is asserted that the orthogonal transformer 104, the quantizer 106, and the coder 107, as disclosed in Takayama, are equivalent to the fixed length coding circuit as claimed. Apparently, the disclosure that a predetermined number of pixels is inputted to the orthogonal transformer 104 has been misinterpreted to satisfy the "fixed length" recitation. However, the fixed length, in actuality, refers to the length of the code

output by the fixed length coding circuit. For the purposes of making this distinction clear only, independent claim 1 has been amended to recite, in part, "wherein a length of the code output from the fixed length coding circuit is fixed."

It is clear that Takayama fails to teach and suggest at least this feature. Moreover, it is well known that the orthogonal transformation coding is a type of variable length coding method. As an explanation, orthogonal transformation, such as discrete cosine transformation, is used to convert a block of image data into a frequency domain data. The length of the code generated from this conversion depends on the variability of the frequency values of the transformed data. Indeed, this is confirmed in U.S. Patent No. 5,032,927 to Watanabe et al. (hereinafter "Watanabe"), used in rejecting other pending claims of this application. See *Watanabe*, column 5, lines 57-68. Because Takayama does not teach or suggest that the output of the orthogonal transformer, quantizer, and coder is fixed length, claim 1 is not anticipated by Takayama.

Claims 18, which recites a similar feature, is also not anticipated by Takayama. Claims 12-14 depend from independent claim 1. Therefore, for at least the reasons stated with respect to independent claim 1, these dependent claims are also not anticipated by Takayama.

Applicants respectfully requests withdrawal of the rejection of claims 1, 12-14, and 18 under 35 U.S.C. §102(e) based on Takayama.

Rejections under 35 U.S.C. §103(a) based on Takayama and Watanabe

Claims 2-4 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Takayama in view of Watanabe. Applicants respectfully traverse this rejection.

For a Section 103 rejection to be valid, a *prima facie* case of obviousness must be established. See *M.P.E.P.* 2142. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. See *M.P.E.P.* 2142; *M.P.E.P.* 706.02(j). Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, claims 2-4 depend from independent claim 1, which recites, in part, "wherein a length of the code output from the fixed length coding circuit is fixed." It has been shown that Takayama does not teach or suggest at least this feature. Watanabe has not been, and indeed cannot be, relied upon to correct for at least this deficiency of Takayama. Further, as shown above, Watanabe actually teaches away from the presently claimed invention.

For at least these reasons, independent claim 1 is not rendered obvious by the combination of Takayama and Watanabe. Therefore, due

at least to their dependency on claim 1, claims 2-4 are also not rendered obvious by the combination of Takayama and Watanabe.

Applicants respectfully request withdrawal of the rejection of claims 2-4 under 35 U.S.C. §103(a) based on Takayama and Watanabe.

Rejection under 35 U.S.C. §103(a) based on Takayama and Iwasaki

Claims 5-7 and 15-17 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Takayama in view of Iwasaki et al. (U.S. Patent No. 5,414,487, hereinafter "Iwasaki"). Applicants respectfully traverse this rejection.

Independent claim 5 recites, in part, "wherein a length of the code output from the fixed length coding circuit is fixed." It has been shown above that Takayama does not teach or suggest at least this feature. Iwasaki has not been, and indeed cannot be, relied upon to correct at least this deficiency of Takayama. Therefore, independent claim 5 is not rendered obvious over the combination of Takayama and Iwasaki.

Claims 6, 7, and 15-17 depend from independent claim 5. Therefore, for at least the reasons stated with respect to independent claim 5, these dependent claims are also not rendered obvious by the combination of Takayama and Iwasaki.

Applicants respectfully requests withdrawal of the rejection of claims 5-7 and 15-17 under 35 U.S.C. §103(a) based on Takayama and Iwasaki.

Rejection under 35 U.S.C. §103(a) based on Takayama, Watanabe, and Iwasaki

Claims 8-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Takayama in view of Watanabe and Iwasaki et al. Applicants respectfully traverse this rejection.

Claims 8-11 depend from independent claim 5, and it has been shown above that none of Takayama, Watanabe, and Iwasaki teaches or suggests the above-recited feature. Indeed, it has been shown that Watanabe actually teaches away from the claimed invention. Therefore, independent claim 5 is not rendered obvious by any combination of Takayama, Watanabe, and Iwasaki.

Therefore, due to at least their dependency on independent claim 5, claims 8-11 are also not rendered obvious by any combination of Takayama, Watanabe, and Iwasaki.

Applicants respectfully requests withdrawal of the rejection of claims 8-11 under 35 U.S.C. §103(a) based on Takayama, Watanabe, and Iwasaki.

New Claims

Claims 19-31 have been added through this Reply. All new claims are believed to be distinguishable over the cited references,

individually or in any combination. For example, independent claims 19 and 24 recite, in part, "wherein a length of the code output for each block is fixed." It has been shown above that no combination of the cited references teaches or suggests at least this feature. Therefore, claims 19 and 24, and the claims dependent thereon, are distinguishable over the cited references.

Applicants respectfully request that claims 19-31 be allowed.

CONCLUSION


All rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance, and such allowance is earnestly solicited. However, should there be any outstanding matters that may be resolved by a telephone conference, the Examiner is invited to contact Hyung Sohn (Reg. No. 44,346) at 703-205-8000 in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

required under 37 C.F.R. §§1.16 or 1.17, particularly extension of
time fees.

Respectfully submitted,

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